

REMARKS

Summary of Office Action

Claim 1 is pending in the application.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimm U.S. Patent No. 5,938,583 (hereinafter "Grimm") in view of Burr et al U.S. Patent Application No. 2001/0049510 (hereinafter "Burr") or Waltereit German Patent No. 4420232 (hereinafter "Waltereit").

Summary of Applicants' Amendments

Applicants have added claims 22-30 in order to more particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Applicants' Response to the Rejections
Under 35 U.S.C. § 103(a)

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Grimm in view of Burr or Waltereit.

Applicants' invention, as defined by independent claim 1, includes a needle, adapted to provide radioactive seeds, having two conductive traces for determining when the needle projects into a patient's bladder so that the radioactive seeds are only dispersed into a patient's prostate.

Grimm discusses a needle for depositing radioactive seeds into the body. Grimm uses a nearby ultrasonic probe to make sure the needle is provided in a particular location of a prostate.

Burr discusses a needle that provides different electrical outputs when the needle penetrates into tissues, veins, or lumens.

Waltereit discusses a needle that converts an electromagnetic parameter value, such as a resistance, across a pair of electrodes into an electrical output signal.

The Examiner stated that "it would have been obvious ... to provide an automatic detection means mounted on the needle ... of Grimm so that a detection system ... mounted on the needle itself [was used]" (Office Action, page 3).

Grimm, however, teaches away from Burr and Waltereit. Particularly, Grimm dismisses the need for any system to determine whether the bladder has been breached by a needle. As Grimm puts it:

"If the needle is inserted too deeply, e.g., into the bladder, that will be immediately recognized by the operator because of the presence of urine in the needle"
(Grimm, Col. 4, lines 57-60)

Accordingly, Grimm teaches away from modifying his system, in any manner, to determine whether a needle projects into a patient's bladder. Thus, neither Grimm and Burr or Waltereit, used either alone or in combination, show or suggest applicants' invention of claim 1 of a needle ,adapted to disperse radioactive seeds, with conductive traces for determining if the needle has punctured into the bladder.

Furthermore, Grimm uses a nearby ultrasound probe to determine the location of a needle in the prostate. In this manner, there is no motivation or suggestion to combine Grimm with Waltereit or Burr to add an additional detection system. Doing so, would only eviscerate the spirit of the Grimm system.

In light of the foregoing applicants respectfully requests that the rejection of claim 1 under 35 U.S.C. § 103(a) in view of Grimm and Burr or Waltereit be withdrawn.

Conclusion

Applicants have demonstrated the claimed subject matter is in condition for allowance.

An early and favorable action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeffrey D. Mullen", is written over a horizontal line.

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